

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.: 09/848,519 Confirmation No.: 7542
Appellant(s): David G. Beshore
Filed: May 4, 2001
Art Unit: 3623
Examiner: Loftis, Johnna
Title: METHOD AND COMPUTER PROGRAM PRODUCT FOR ASSESSING
A PROCESS OF AN ORGANIZATION

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SECOND REPLY BRIEF UNDER 37 CFR § 41.41

This Second Reply Brief is filed pursuant to 37 CFR § 41.41 and is filed in response to the Second Examiner's Answer of December 16, 2008. The Second Examiner's Answer essentially repeats the substance of the First Examiner's Answer of November 28, 2007 (responsive to an Appeal Brief filed September 14, 2007), but now adds a new ground of rejection – either or both Examiner's Answer's referred to herein as the "Examiner's Answer." This Second Brief generally addresses a number of points arising from the Appeal Brief, as well as the Examiner's Answer to the same. More particularly, this Second Brief essentially repeats the substance of Appellant's First Reply Brief filed January 9, 2008, but further addresses the new ground of rejection presented in the Second Examiner's Answer.

6. *Grounds of Rejection to be reviewed on Appeal.*

Currently, all of the pending claims, namely Claims 1-20, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the publication Susann Wilkinson, *Evaluation Report for Grant #R13 HG00793-0142: Impact of Human Genome Initiative on Society: A Women's Study Approach* (hereinafter "Wilkinson"), in view of Official Notice of facts outside the record. In

addition, Claims 1-6 and 15-20 now stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. All of the pending claims are presently being appealed.

7. **Argument.**

All of the pending claims, namely Claims 1-20, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wilkinson, in view of Official Notice of facts outside the record; and Claims 1-6 and 15-20 now stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Appellant addresses the obviousness rejection in Appellant's Appeal Brief, as well as in the Response to Argument section below; and as such, will not again address the rejection in this section. The rejection of Claims 1-6 and 15-20 as being directed to non-statutory subject matter, however, is newly presented in the Second Examiner's Answer, and is addressed below. As explained below, Appellant respectfully submits that the Examiner did not establish a *prima facie* case that the method claims do not recite statutory subject matter.

In the Second Examiner's Answer, the Examiner newly rejects Claims 1-6 and 15-20 as being directed to non-statutory subject matter, stating:

... Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1987); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876).

... Here, applicant's method claims fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus. Thus, claims 1-6 and 15-20 are non-statutory since they may be performed within the human mind.

Second Examiner's Answer of Dec. 16, 2008, pages 3-4.

Notably, although the Examiner identifies precedent stating that a statutory process may be one that satisfies either of two prongs ("machine" or "transformation"), the Examiner only treats Appellant's claims under the first prong, alleging that Claims 1-6 and 15-20 are not tied to a particular apparatus. This alone, however, does not establish a *prima facie* case that the claims are non-statutory as the claims may in fact satisfy the second prong. That is, the method claims

may in fact transform a particular article to a different state or thing. The Examiner, however, provides absolutely no analysis or conclusions with respect to the second prong; and as such, has not properly established that the claims are non-statutory.

In the Second Examiner's Answer, the Examiner does suggest that the second prong requires transformation of subject matter in the form of an article or materials. As has been recognized by the Federal Circuit, however, the transformation prong of the test for patentable subject matter may be satisfied by the transformation of "electronic signals and electronically-manipulated data." *In re Bilski*, 545 F.3d 943, 962 (Fed. Cir. 2008). And as recited by independent Claims 1 and 15 recite electronic voting and development of findings (final findings) based upon that voting.

10. ***Response to Argument.***

The Examiner's Answer responded to Appellant's arguments under subsections A and B of section 7 of the Appeal Brief. Accordingly, Appellant addresses the Examiner's position under those same subsections below. Again, currently, pending Claims 1-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the publication Susann Wilkinson, *Evaluation Report for Grant #R13 HG00793-0142: Impact of Human Genome Initiative on Society: A Women's Study Approach* (hereinafter "Wilkinson"), in view of Official Notice of facts outside the record.

A. Claims 1-14 are Patentable over Wilkinson

1. Acquisition of Information Concerning an Organization and Process

As explained in Appellant's Appeal Brief, in contrast to independent Claim 1, and similarly independent Claim 7, Wilkinson does not teach or suggest acquiring information concerning an organization and process of the organization, and the Examiner has failed to establish its inherency within Wilkinson. In addition, the Examiner appears to illogically assert its relationship with the disclosure of Wilkinson allegedly supporting the claimed feature of developing findings based upon that information.

**(a) Inherency of Acquiring Information Concerning an Organization
and Process Thereof**

As explained in Appellant's Appeal Brief, in contrast to independent Claim 1, and similarly independent Claim 7, Wilkinson does not teach or suggest acquiring information concerning an organization and process of the organization, and the Examiner has failed to establish its inherency within Wilkinson. In the Examiner's Answer, the Examiner asserts as follows:

... The principles that are considered in the WAGICS evaluation report [of Wilkinson] concern the organization and the process. As claimed, any such information that concerns any organization and/or process reads on the limitation of the claim. As for acquiring the information, the mere fact that the information is included in the assessment proves the information was previously acquired so as to enable the assessment to take place.

Examiner's Answer, pages 10-11. Appellant respectfully disagrees with these assertions on a number of grounds.

Initially, Appellant again stresses that the Examiner bears the burden of establishing inherency in the prior art. More particularly, as explained in the MPEP, "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or in technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." MPEP § 2112 (*quoting Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original)). To establish inherency, evidence must make clear that the missing descriptive matter is necessarily present in the prior art, and would be recognized as being present in the prior art by those skilled in the art.

"Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999), *citing Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 1269 (Fed. Cir. 1991) (emphasis added).

As to the Examiner's added assertions in the Examiner's Answer, Appellant notes that contrary to those assertions, any information that concerns any organization and/or process does not in fact read on the claimed invention. Rather, the claims clearly require assessing a process

of an organization, and acquiring information concerning not only the process but also the organization (i.e., acquiring information concerning the organization and the process). Thus, to read on the claims, information must be acquired as part of an assessment (i.e., a method for assessing) of a process of an organization, and must concern the organization and the process. And again, the Examiner has failed to provide any facts or technical reasoning to support her conclusion that Wilkinson inherently discloses the aforementioned acquisition of information concerning both the organization and the process. And more particularly, the Examiner has failed to cite any supporting evidence to establish that evaluation of the principles of Table 3 necessarily result in the acquisition of information concerning both the meeting and ELSI (noting without admission that the Examiner has alleged that ELSI corresponds to the recited organization).

Moreover, Appellant notes that the assertion that “the mere fact that information is included in the assessment proves the information was previously acquired so as to enable the assessment to take place” does not in fact establish inherency of acquiring information concerning both the organization and the process being assessed. In this regard, even if one could argue that information was acquired to enable the disclosed assessment, nowhere does Wilkinson explicitly or inherently teach or suggest that the acquired information concerns not only the process of the organization, but also the organization, as recited by the claimed invention.

***(b) Developing Preliminary Findings based upon Information
Concerning an Organization and Process Thereof***

As also explained in Appellant’s Appeal Brief, in contrast to independent Claim 1, and similarly independent Claim 7, Wilkinson does not teach or suggest acquiring information concerning an organization and process of the organization, and the Examiner appears to illogically assert its relationship with the disclosure of Wilkinson allegedly supporting the claimed feature of developing findings based upon that information. The added assertions in the Examiner’s Answer only further this illogical relationship.

In the Examiner's Answer, the Examiner asserts that:

... Examiner asserts that the mere fact that the information is presented to a survey participant supports the idea that this information was collected and assessed in such a way so that "preliminary findings" were developed so that participants could perform a voting operation. For example, referring to Table 3, one of the principles that are voted upon includes, "suggested readings for the Workshop are relevant". Examiner views this principle as a preliminary finding, i.e., the organization running the Workshop feels the readings are relevant and pose this principle for voting to find out if participants agree.

Examiner's Answer, page 11. By the foregoing, the Examiner seems to maintain that the disclosed surveys of Wilkinson present the allegedly acquired information; and that the same information corresponds to preliminary findings. According to the claimed invention, however, the preliminary findings are not the same as the acquired information, but are instead developed based on the acquired information.

Appellant submits that nothing in Wilkinson teaches or suggests that the "organization running the Workshop feels the readings are relevant," as asserted by the Examiner. One may argue that the organizers of the Workshop were guided by a principle of having relevant suggested readings for the Workshop. But to further assert that the organizers feel that this principle was actually met (assert that the organizers feel the readings are relevant) goes well beyond the explicit or inherent teachings of Wilkinson. In this regard, nothing in Wilkinson explicitly discloses that the organizers feel that the suggested readings were relevant; and equally, nothing in Wilkinson renders the feelings of the organizers as "necessarily" part of the survey.

2. *Inherency of Strength/Weakness Characterizations*

As explained in Appellant's Appeal Brief, the Examiner appears to concede that Wilkinson does not explicitly disclose preliminary or final findings having associated strength or weakness characterizations. Nonetheless, the Examiner alleges that this feature is inherent in Wilkinson since such characterizations are subjective and that, while the theoretical principles presented to the participants for agreement voting mostly include strengths, one or more of those principles may be viewed by some as weaknesses. To the contrary, however, even if the

principles disclosed by Wilkinson could have associated strength/weakness characterizations, this does not establish inherency of such characterizations in Wilkinson. Rather, establishing inherency of the aforementioned feature requires evidence establishing that principles necessarily do include such characterizations, as opposed to a probability or possibility of including those characterizations.

In the Examiner's Answer, the Examiner explains as follows:

As understood by the examiner [sic], an associated characterization of something is viewed as an inherent trait or quality. Examiner asserts that each finding inherently has an associated characterization as either a strength or weakness of the organization, wherein each participant expresses whether or not they agree with the finding and its inherent characterization. In the WAGICS reference [i.e., Wilkinson], most findings are characterized as inherent strengths of the organization, i.e., the readings are relevant (inherent strength of the process).

Examiner's Answer, page 12. Once again, however, Examiner still fails to establish this inherency. That is, nowhere does the Examiner provide any facts or technical reasoning to support her conclusion that Wilkinson inherently discloses the aforementioned strength/weakness characterizations. The Examiner again alleges that most of the principles are characterized as inherent strengths. But not only does the Examiner fail to provide facts or technical reasoning for her conclusion that most of the principles are inherently characterized as strengths, but her allegation does not support that the principles inherently include strength/weakness characterizations in the first place. Appellant again notes that in the only substantive attempt to provide such reasoning to support the inherency of characterizations, proffered in the second Official Action, the Examiner's explanation clearly demonstrated that the principles of Wilkinson do not necessarily, and thus inherently, include associated strength/weakness characterizations, similar to the claimed invention. *See* Official Action of Dec. 5, 2005, page 3 (“[W]hile the principles listed in the WAGICS Evaluation Report mostly reflect strengths of the workshop, characterization of strength and weakness is very subjective and what one views as a strength might be characterized as a weakness to another.” – emphasis added).

In a further, and now presented for the first time, attempt to dismiss the aforementioned feature of the claimed invention, the Examiner asserts that:

... Examiner points out that, as claimed, the findings have an associated characterization, but the voting is for agreement or disagreement with the finding. Further, this characterization is claimed as a mere label. These labels (strength or weakness), have no affect on the methodology and therefore are considered non-functional data. While the WAGICS reference [i.e., Wilkinson] teaches voting for agreement or disagreement with findings, the reference does not explicitly teach the findings are labeled as strength or weakness. The labels are not functionally involved in the manipulative steps of the invention nor do they alter the recited structural elements; therefore, such differences do not effectively serve to patentably distinguish the claimed invention over the prior art. The manipulative steps of the invention would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability as the claimed invention fails to present a new and unobvious functional relationship between the descriptive material and the substrate.

Examiner's Answer, pages 11-12, citing *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336 (Fed. Cir. 2004); and MPEP § 2106 (emphasis in original). In response, however, Appellant first notes that as explained below and in the Appeal Brief, at least dependent Claim 6, and similarly dependent Claim 12 (and independent Claim 15), does in fact recite voting for agreement or disagreement with the characterization (strength or weakness) of each preliminary finding (i.e., voting for a valuation), and developing final findings further based upon the aforementioned voting.

Second, Appellant notes that independent Claim 1 (and similarly independent Claim 15) recites development of preliminary and final findings including characterizing and labeling each respective finding as a strength/weakness, and independent Claim 7 recites presenting developed findings each of which has been characterized and labeled as a strength/weakness. Appellant therefore submits that as development and/or presentation of findings is part of the recited methodology, and that as this development and/or presentation includes characterizations and labels, those characterizations and labels are in fact involved in the invention as more than mere labels. Rather, the characterizations are an integral part of the findings and assessment developed as part of the assessment of the process of the organization.

For at least the foregoing reasons, as well as those presented in Appellant's Appeal Brief, Appellant respectfully submits that independent Claim 1, and similarly independent Claim 7, is patentably distinct from Wilkinson. And as dependent Claims 2-6 and 8-14 include all the limitations of respective ones of independent Claims 1 and 7, dependent Claims 2-6 and 8-14 are also patentably distinct from Wilkinson for at least the reasons given above. In addition, Appellant respectfully submits that various ones of dependent Claims 2-6, 8-14 and 16-20 recite features further patentably distinct from Wilkinson.

(a) Dependent Claims 6 and 12

As indicated above, explained in Appellant's Appeal Brief, and without any counterpoints in the Response to Arguments section of the Examiner's Answer, dependent Claim 6, and similarly dependent Claim 12, for example, further recites voting for agreement or disagreement with the characterization (strength or weakness) of each preliminary finding (i.e., voting for a valuation), and developing final findings further based upon the aforementioned voting step. As explained above, Wilkinson does not teach or suggest, explicitly or inherently, preliminary or final findings having associated strength or weakness characterizations. Thus, Wilkinson also does not teach or suggest, explicitly or inherently, voting for agreement or disagreement with those characterizations. Moreover, even if one could argue (albeit incorrectly) that Wilkinson inherently discloses that the questionnaire items are inherently characterized as strengths or weaknesses by virtue of the subjective nature of such a characterization, Wilkinson still does not teach or suggest voting for agreement or disagreement with the characterization of findings as strengths or weaknesses, as recited by dependent Claims 6 and 12.

3. Improper Official Notice

As explained in Appellant's Appeal Brief, the Examiner concedes that Wilkinson does not teach or suggest labeling the theoretical principles that guided the process of organizing the meeting, shown in Table 3 of Wilkinson (allegedly corresponding to preliminary/final findings) with strength/weakness characterizations, similar to the findings of the claimed invention.

Nonetheless, the Examiner takes Official Notice that one skilled in the art would have found it obvious to modify Wilkinson to include this feature, with the alleged motivation being to provide more information for the assessor to enable him/her to provide the most accurate assessment of the organization. Appellant respectfully disagrees and, not only traverses the taking of Official Notice, but the allegation that one skilled in the art would have been motivated to modify Wilkinson, to enable the most accurate assessment.

In the Examiner's Answer, the Examiner again challenges the pertinence of the characterizations and labels to the claimed invention. Notably, however, the Examiner continues to fail to provide any remarks or other evidence supporting the Examiner's taking of Official Notice as to the obviousness of the claimed invention. That is, nowhere has the Examiner demonstrated that the alleged Official Notice has only been taken of facts that are "capable of instant and unquestionable demonstration as being well-known." MPEP § 2144.03(A.), *citing In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970).

Again, Appellant respectfully submits that the Examiner did not in fact take Official Notice of facts capable of instant and unquestionable demonstration as being well known so as to defy dispute. If, as alleged (but expressly not admitted), the theoretical principles that guided the process of organizing the meeting, shown in Table 3 of Wilkinson (allegedly corresponding to preliminary/final findings) inherently reflect their characterizations as strengths/weaknesses, then those principles must necessarily reflect their characterizations (see above as to the requirement for properly asserting an inherent disclosure). If the principles necessarily reflect their characterizations, as alleged (but expressly not admitted), one could argue that those skilled in the art could just as easily interpret the inherently-reflected characterizations without labels identifying those characterizations, contrary to the Official Notice taken by the Examiner.

Thus, the Examiner has taken Official Notice that it would have been obvious to label the theoretical principles of Table 3 of Wilkinson with their inherently-reflected strength/weakness characterizations. Appellant respectfully submits, however, that it is equally plausible that if the theoretical principles inherently reflect strength/weakness characterizations, as alleged (but expressly not admitted), one skilled in the art could interpret those characterizations without any labels identifying those characterizations. Therefore, Appellant respectfully submits that the

assertion that it would have been obvious to label the theoretical principles of Table 3 of Wilkinson with their inherently-reflected strength/weakness characterizations is not capable of instant and unquestionable demonstration as being well known so as to defy dispute, as required to take Official Notice of facts not in the record.

4. No Motivation to Modify Wilkinson

Moreover, Appellant once again submits that one skilled in the art would not have been motivated to modify Wilkinson to include characterization labels, as alleged by the Examiner. Again, if the principles necessarily reflect their characterizations, as alleged (but expressly not admitted), one could argue that those skilled in the art could just as easily interpret the inherently-reflected characterizations without labels identifying those characterizations. In other words, if the theoretical principles that guided the process of organizing the meeting, shown in Table 3 of Wilkinson (allegedly corresponding to preliminary/final findings) inherently reflect their characterizations as strengths/weaknesses, why would one skilled in the art need or even desire to further label those principles with their respective characterizations. More particularly, borrowing the example in the Official Action, if the principle, "suggested reading were useful in accomplishing workshop goals," inherently conveys a strength, as alleged (but expressly not admitted), why would one skilled in the art need or desire for the principle to include a label expressly identifying the usefulness of suggested reading as a strength.

For at least the foregoing reasons, Appellant respectfully submits that independent Claim 1 and similarly independent Claim 7, and by dependency Claims 2-6 and 8-14, are patentably distinct from Wilkinson.

B. Claims 15-20 are Patentable over Wilkinson

As explained in Appellant's Appeal Brief, in contrast to independent Claim 15, Wilkinson does not teach or suggest assessing a process of an organization according to a method that includes developing preliminary findings based upon information concerning the organization and the process, where each finding is characterized as either a strength or weakness, as explained above with respect to independent Claim 1. Also in contrast to

independent Claim 15, Wilkinson does not teach or suggest voting for agreement or disagreement with strength or weakness characterizations of the preliminary findings. As to the similar subject matter of dependent Claim 6, the Examiner alleges that Wilkinson discloses voting for agreement/disagreement with the theoretical principles of Table 3 and their inherent characterizations. Appellant again respectfully submits, however, that Wilkinson does not in fact inherently (or explicitly) disclose strength/weakness characterizations for the theoretical principles of Table 3. And even further, Wilkinson does not teach or suggest voting for agreement/disagreement with strength/weakness characterizations for the theoretical principles of Table 3 (even if one could argue that the principles inherently include strength/weakness characterizations – although, yet again, expressly not admitted).

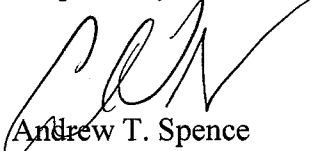
Appellant notes that in the Examiner's Answer, the Examiner alleges that "as claimed, the findings have an associated characterization, but the voting is for agreement or disagreement with the finding." Examiner's Answer, page 14 (emphasis in original). To the contrary, however, Appellant notes that independent Claim 15 quite clearly recites voting for agreement or disagreement with the strength/ weakness characterizations of the preliminary findings.

Thus, for at least the same reasons given above with respect to independent Claim 1, and for the additional reason given immediately above and in Appellant's Appeal Brief, Appellant respectfully submits that independent Claim 15, and by dependency Claims 16-20, is also patentably distinct from Wilkinson.

CONCLUSION

For at least the foregoing reasons, as well as those presented in the Appeal Brief, Appellants respectfully request that the rejections be reversed.

Respectfully submitted,



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